

REMARKS/ARGUMENTS

The rejections presented in the first Office Action have been considered. Claims 1-23 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 1-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2006/0125927 by Watanabe (hereinafter “*Watanabe*”). The Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness based on a single reference, three basic criteria must be met, as is set forth in M.P.E.P., §2143:

- 1) There must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art references must teach or suggest all of the claim limitations.

Pending Claims 1, 10, 16, 19, 20 and 23 are independent claims. Claim 1 is first considered. Claim 1 includes activating a keyhole frame within a display of a hosting terminal that is used by a first participant, which is streamed to a mobile terminal used by a second participant. The first participant also establishes a voice connection with the second participant’s mobile terminal. The keyhole frame represents a movable and dimensionally resizable frame of what is otherwise presented on the hosting terminal’s display (see, e.g., Applicant’s Specification page 8, lines 9-11). FIG. 1 of the Applicant’s application illustrates an example of a keyhole frame 114, which in the embodiment of FIG. 1 is a user-identifiable portion of the image, video or other graphics presented on the hosting terminal. The keyhole frame presents a portion of the display that lies within the keyhole frame may be captured for subsequent transfer/storage within the communication device being used (see, e.g., Applicant’s Specification page 8, lines 26-29).

The Office Action identifies *Watanabe* as teaching activating a keyhole frame within a display of a hosting terminal. Page 6, paragraphs 118 and 122 are specifically cited as teaching this claimed feature. Page 6, ¶118 of *Watanabe* describes a way of selecting an image via a selection menu. A “frame number” (*i.e.*, name of the image) can be selected, which upon selection presents an associated thumbnail image. Page 6, ¶122 then indicates that when the user selects this image name, data designating that image name is sent to the digital still camera 1A.

The Office ostensibly takes the position that the mobile device serves as the hosting device, and the “keyhole frame” is an image – specifically, a thumbnail image. However, *Watanabe* is silent as to any keyhole frame, and a thumbnail image does not correspond to the claimed keyhole frame that delineates a portion of the display to capture. As indicated above, the keyhole frame relates to a delineated subset (which can include the entire set) or portion of a displayed image. Nothing in *Watanabe* teaches or suggests providing such a manner of viewing a desired dimensional area(s) of the displayed image, video or other visual presentation. For at least this reason, it is respectfully submitted that *Watanabe* fails to teach or suggest all of the limitations of Claim 1.

In order to facilitate prosecution of the application, Claim 1 has been amended to more clearly set forth an embodiment of a “keyhole frame.” Thus, in Claim 1, the keyhole frame represents a user-specified dimensional subset of what is displayed via the hosting terminal display. *Watanabe* clearly does not teach, or suggest, any such manner of specifying a dimensional portion of the displayed image for delivery to another device or system. For at least this additional reason, it is respectfully submitted that *Watanabe* fails to teach or suggest all of the limitations of Claim 1.

Furthermore, Claim 1 involves streaming image data within the specified keyhole frame from the hosting terminal to a mobile terminal via a stream connection therebetween. The Examiner has taken the position that the mobile device of *Watanabe* where the desired image is selected serves as the hosting device. The mobile device of *Watanabe* would then have to send a keyhole frame to a mobile device proximately located to a second participant via a stream connection, which the Applicant respectfully submits it does not. More

particularly, the Examiner cites page 6, ¶127 as teaching this recited feature. However, ¶127 states that the portable phone 40A receives resized image data from the digital still camera 1A, and then the portable phone 40A sends image data to a receiving portable phone. It is first noted that this does not teach or suggest, contrary to what is alleged in the Office Action, establishing a stream connection and streaming image data. Rather, *Watanabe* mentions nothing about streaming information, but rather only suggests that a static image is transmitted. In other words, the data is merely sent as a file, versus dynamically streaming data from a keyhole frame or elsewhere. In fact, the Claim 1 limitation of “establishing a stream connection...” is not addressed in the Office Action. For at least this additional reason, *prima facie* obviousness has not been established. A further point relating to the streaming of image data in Claim 1 is that only that portion of the image that is within the designated keyhole frame is transmitted. No such transmission limitations are taught or suggested in *Watanabe*. For at least this additional reason, *prima facie* obviousness has not been established.

The Examiner notes that *Watanabe* does not explicitly teach establishing a voice communication between the first and second participants in addition to the other steps. The Examiner argues that at page 5, paragraphs 99-106 *Watanabe* discloses “a communication circuit of the mobile/host terminal for providing voice communications.” However, Claim 1 involves a *method* that includes establishing a voice communication. Even assuming *arguendo* that *Watanabe* teaches a communication circuit, this does not teach or suggest establishing a voice communication in connection with the remaining limitations of Claim 1. There is nothing in *Watanabe* that teaches, or suggests, that a voice communication would be established between the participants of the communication session in combination with the activation of the keyhole frame, establishing a stream connection, streaming image data, etc. There is no need or stated problem to be solved by establishing a voice communication in *Watanabe*, and there is no motivation to modify *Watanabe* to establish a voice communication in connection with *Watanabe*’s disclosed system. The mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01, citing *In re*

Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Thus, because *Watanabe* fails to teach or suggest this limitation, and because there is nothing that would suggest a need or purpose for establishing a voice communication and thus there is no motivation to modify *Watanabe* in the stated fashion, *prima facie* obvious is not established for this additional reason.

Dependent Claims 2-9, which are dependent from independent Claim 1, were also rejected under 35 U.S.C. §103(a) as being unpatentable over *Watanabe*. While Applicant does not acquiesce with any particular rejections to these dependent claims, including any assertions concerning common knowledge, obvious design choice and/or what may be otherwise well-known in the art, it is believed that these rejections are now moot in view of the remarks made in connection with independent Claim 1. These dependent claims include all of the limitations of Claim 1 and any intervening claims, and recite additional features which further distinguish these claims from the cited references. “If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.” M.P.E.P. §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2-9 are also allowable over the modified *Watanabe* reference.

As a further example of the inapplicability of *Watanabe* relative to these dependent claims, Claim 2 indicates that activating the keyhole frame involves defining an area within the display of the hosting terminal to represent the keyhole frame, which Claim 1 indicates is a user-specified dimensional subset of what is displayed via the hosting terminal display. *Watanabe*’s selection of a frame number/item does not teach or suggest the activation of the keyhole frame involves defining an area within the display of the hosting terminal to represent the keyhole frame. Claims 3 and 4 respectively include features involving length and width constraints, and centering the keyhole frame around an active cursor of the hosting terminal, neither of which is described in *Watanabe*. Further, Claims 6-9 include various limitations that are not addressed in the Office Action, and a plurality of claims should not be grouped together in a common rejection unless that rejection is equally applicable to all claims in the group. M.P.E.P. § 707.07(d). For at least these additional reasons, *prima facie* obviousness has not been established.

Regarding Claims 10-18, the Examiner argues that *Watanabe* teaches these claims. The Applicant respectfully traverses the rejection. Independent Claim 10 includes a keyhole frame application adapted to place a keyhole frame anywhere within a viewable area of the display. As indicated above, *Watanabe* does not teach or suggest the placement of any frame at any place within a viewable area of what is being displayed. Additionally, the keyhole frame application of Claim 10 is adapted to transmit image data, that is contained within the keyhole frame, to the second mobile terminal via a data connection. As previously contended, *Watanabe* does not teach, suggest or otherwise allude to any transmission of data that is within such a keyhole frame. For at least these reasons, *Watanabe* fails to teach or suggest all of the limitations of independent Claim 10, and thus *prima facie* obviousness has not been established.

Independent Claim 16 was also rejected based on *Watanabe*, and the Applicant respectfully traverses the rejection. As previously argued, *Watanabe* does not teach or suggest anything relating to a keyhole frame and/or user designation of some dimensional portion of a display that is to be transmitted elsewhere. Notwithstanding at least these differences, Claim 16 has been amended to facilitate prosecution of the application by including features relating to the keyhole frame module. It is respectfully submitted that *Watanabe* fails to teach or suggest at least these limitations, as it is silent as to such keyhole frame features. For at least these reasons, independent Claim 16 is also patentable over the cited art of record.

Dependent Claims 11-15 and 17-18, which are dependent from independent Claims 10 and 16 respectively, also stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Watanabe*. While Applicant does not acquiesce with any particular rejections to these dependent claims, including any assertions concerning common knowledge, obvious design choice and/or what may be otherwise well-known in the art, it is believed that these rejections are moot in view of the remarks made in connection with independent Claims 10 and 16. These dependent claims include all of the limitations of their respective base claim and any intervening claims, and recite additional features which further distinguish these

claims from the cited references. Thus, dependent Claims 11-15 and 17-18 are also allowable over *Watanabe*.

The Examiner indicated that the rationale for rejecting Claims 19-23 is the same as that for Claims 1-18. The Applicant respectfully traverses the rejection. For example, independent Claim 19 is directed to a computer-readable medium where instructions enable the providing of commands to the hardware platform that affect the video data received from the hardware platform, and where these commands are provided via one of the first connection or second connection. This is not taught or suggested by *Watanabe*, nor does the Office Action cite where *Watanabe* teaches or suggests such claimed feature. Additionally, in order to facilitate prosecution of the application, Claim 19 has been amended to highlight the keyhole frame aspect where the received video data represents a dimensional subset of the hardware platform's display. As previously remarked, this is not taught or suggested by *Watanabe*. For at least these reasons, Claim 19 is not rendered obvious by the cited reference.

Claim 20 has also been amended to facilitate prosecution of the application. In order to facilitate prosecution of the application, Claim 20 has been amended. *Watanabe* at least fails to teach or suggest any means for generating video data contained within a keyhole frame. More particularly, *Watanabe* fails to teach or suggest that a framed portion of what is displayed is capable of being captured and/or transmitted. Further, the keyhole frame of Claim 20 is defined by keyhole frame parameters that lie within a user-specified dimensional portion of the display region of the hardware platform, and again *Watanabe* fails to teach or suggest this feature. For at least these reasons, *Watanabe* fails to teach or suggest all the limitations of Claim 20, and thus Claim 20 is allowable over *Watanabe*.

Similarly, independent Claim 23 has been amended, and *Watanabe* at least fails to teach or suggest any means for generating video data contained within a keyhole frame. More particularly, *Watanabe* fails to teach or suggest that a framed portion of what is displayed is capable of being captured and/or transmitted. The keyhole frame of Claim 23 is defined by keyhole frame parameters that lie within a user-specified dimensional portion of the display region of the hardware platform, and again *Watanabe* fails to teach or suggest

this feature. Additionally, Claim 23 includes instructions for providing video data to the mobile terminal via the second connection, where external commands are received that change the keyhole frame parameters. Again, *Watanabe* fails to teach or suggest the use of such external commands to change keyhole frame parameters that lie within a user-specified dimensional portion of the display region. For at least these reasons, *Watanabe* fails to teach or suggest all the limitations of Claim 23, and thus Claim 23 is also allowable over *Watanabe*.

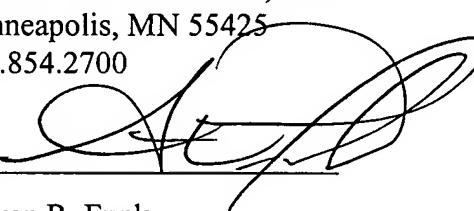
As set forth in M.P.E.P § 2143, there are three requirements required to establish *prima facie* obviousness. A *prima facie* case of obviousness is not established if any one or more of these requirements are not met. Because the *Watanabe* reference as modified by the Examiner does not teach or suggest all the claim limitations in the currently pending claims, it is respectfully submitted that *prima facie* obviousness is not established for these claims. However, the Applicant does not acquiesce with the stated motivations to modify the *Watanabe* reference. The reason, suggestion, or motivation to combine may be found explicitly or implicitly in the prior art references themselves, in the knowledge of those of ordinary skill in the art that certain references or disclosures in those references are of special interest or importance in the field, or from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem. While the Applicant does not acquiesce that the proper motivation to modify the cited reference has been established and/or the reasonable expectation of success has been established, it is respectfully submitted that *prima facie* obviousness is not established at least because all claim limitations are not taught or suggested by *Watanabe*, even as modified in the Office Action. The Applicant reserves the right to further address other requirements for establishing *prima facie* of obviousness for these and/or other cited combinations of references if the circumstances warrant such a response to a contention of *prima facie* obviousness.

Authorization is given to charge Deposit Account No. 50-3581 (NOKM.087PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

Date: June 15, 2007

By: 

Steven R. Funk
Reg. No. 37,830